

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed April 16, 2004. Reconsideration and allowance of the application and pending claims are respectfully requested.

Allowable Subject Matter

Applicant appreciates the Examiner's indication that claims 2-3 and 19-20 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

In that it is believed that every rejection has been overcome, it is submitted that each of the claims that remains in the case is presently in condition for allowance.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1 and 4-18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Pollack (U.S. Pat. No. 6,505,236) in view of Luzeski, et al. ("Luzeski," U.S. Pat. No. 6,430,177). Applicant respectfully traverses this rejection.

As is indicated above, each of Applicant's independent claims has been amended. In view of those amendments, Applicant respectfully submits that the rejection is moot as having been drawn against the claims in a previous form. Applicant, however, provides comments as to the applicability of the applied references as to Applicant's claims in their present state for the Examiner's consideration in the following.

Pollack describes a network-based mail attachment storage system and method. In that system and method, a receiving portal 12 positioned at the recipient end of a communication transmission receives electronic mail items 14 that have been actually

transmitted by and from a sender 16. Pollack, column 4, lines 3-6; Fig. 1. Once an electronic mail item is received by the portal, the storage system detaches an attachment of the mail item and stores the attachment. Id. At column 4, lines 25-39.

When the Pollack system is compared to Applicant's system, it is clear that the Pollack system is distinct from Applicant's system. One significant difference is that, contrary to Applicant's system, the Pollack system does not act *before* an email message is sent from the original sender toward the intended recipient. Instead, as indicated above, Pollack's system acts *after* the sender transmits an email message (i.e., upon receiving that transmitted message). Therefore, the Pollack system is reactive instead of proactive.

In view of the above, Pollack clearly does not teach or suggest "determining a size of an electronic mail message *after the original sender attempts to send said message to an intended recipient but prior to actual transmission of said message from the sender* toward the recipient", as is provided in claim 1. Again, Pollack's system only acts *after* the sender sends a message. Moreover, even if one were to consider the intended recipient (22 in Fig. 1) as a later "sender" of the electronic mail attachment, the recipient is not the "original" sender and Pollack's system still would not act after that "sender" attempts to send a message but before actual transmission of the message.

The other independent claims contain similar limitations. For example, claim 8 recites "means for routing data sets over the network, including means for determining size of a data set to be routed to a predetermined electronic mail destination *after an original sender attempts to send said data set but prior to actual transmission of said data set from the sender* toward an intended recipient". Referring to claim 14, recited is a routing subsystem that "determines the size of said

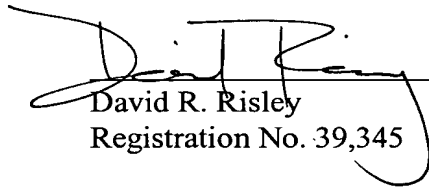
data set *upon an original sender attempting to send said data set via electronic mail but before said data set is actually transmitted from the sender* toward an intended recipient”. Finally, with reference to claim 18, recited is “computer readable coded instructions for transmitting said data set from the sender directly to a data storage site instead of the intended recipient if said data set size is greater than the threshold, said instructions for transmitting said data set directly to a data storage site *being activated by an attempt by the original sender to send said data set to the intended recipient prior to actual transmission of said data set toward the intended recipient*”.

Applicant further submits that Luzeski likewise fails to teach or suggest the above-described recitations. Applicant therefore respectfully submits that Applicant’s claims are allowable over the Pollack/Luzeski combination for at least the reasons provided above and respectfully requests that the rejection be withdrawn.

CONCLUSION

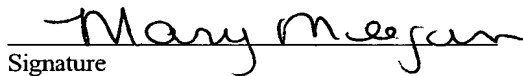
Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

June 29, 2004


Signature